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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Teddy S.p.A.

Serial No. 78/074,844

John P. Murtaugh of Pearne & Gordon LLP for Teddy S.p.A.

Dezmona J. Mizelle, Trademark Examining Attorney,¹ Law
Office 110 (Chris Pedersen, Managing Attorney).

Before Simms, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Teddy S.p.A., an Italian company, has appealed from
the final refusal of the Trademark Examining Attorney to
register RINASCIMENTO and design, as shown below,



for the following goods:

¹ The present Examining Attorney wrote the appeal brief; a
different Examining Attorney examined the application.

Bags, handbags, purses, wallets, suitcases, beauty cases sold empty, document cases, umbrellas, handsacks, namely clutch bags, and luggage (Class 18); and

Clothing, namely shirts, socks, dresses, skirts and trousers; footwear, headwear, jackets, overcoats, raincoats, pullovers, jerkins, hats, scarves, foulards (Class 25).²

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark RENAISSANCE, previously registered for women's sweaters,³ that, if it were used on applicant's identified goods, it would be likely to cause confusion or mistake or to deceive. Registration has also been refused because of applicant's failure to provide an acceptable translation of its mark.⁴

The appeal has been fully briefed; applicant did not request an oral hearing.

We turn first to the requirement for an acceptable translation. Applicant has submitted the following translation of its mark: The English translation of

² Application Serial No. 78/074,844, filed July 25, 2001, and asserting a bona fide intention to use the mark in commerce.

³ Registration No. 1,504,036, issued September 13, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

⁴ The Examining Attorney states in her brief that the sole issue on appeal is that of likelihood of confusion. However, it is clear from her brief that the requirement for an acceptable translation has not been withdrawn, and applicant has proceeded with that understanding.

RINASCIMENTO is REBIRTH or REINCARNATION, relying on the translation provided in a third-party registration, No. 2,271,764. The Examining Attorney has refused to accept this translation, contending that the proper translation of RINASCIMENTO is RENAISSANCE. In support of this position the Examining Attorney has submitted an excerpt from an Italian-English Dictionary in which "rinascimento" is translated as "the Renaissance". It is also noted that this same excerpt lists "rebirth, revival" as the translation of "rinascita." In addition, the Examining Attorney made of record an excerpt from AllWords.com in which "Rinascimento" is given as the Italian translation of "Renaissance," which is defined as "the revival of arts and letters which formed the transition from the Middle Ages to the modern world."

The evidence submitted by the Examining Attorney clearly shows that the English translation of the Italian word "Rinascimento" is "Renaissance." The only evidence submitted by applicant to rebut this evidence is a translation listed in a third-party registration. However, in general, simply because an applicant has made a statement in an application does not prove the truth of that statement. Here, the fact that a third-party applicant provided a translation in a different

application, and the Examining Attorney who examined that application accepted the translation, does not prove that "Rinascimento" means "rebirth" or "reincarnation."⁵ Accordingly, we affirm the Examining Attorney's requirement for an acceptable translation.

This brings us to a consideration of the refusal on the ground of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Examining Attorney bases her refusal on the doctrine of foreign equivalents, under which foreign words

⁵ Although we recognize one of the definitions of the English word "renaissance" is "a rebirth, revival", it is clear from the record that the translation of the Italian word is "Renaissance" and not "rebirth." Moreover, "Renaissance" is also defined in English as "The humanistic revival of classical art, literature, and learning that originated in Italy in the 14th century and later spread through Europe" and "The period of this revival, roughly from the 14th through the 16th century," see The American Heritage Dictionary of the English Language, © 1970, and this meaning is reinforced by the design element in applicant's mark, which is an outline of the head of Venus from the Renaissance artist Botticelli's famous painting The Birth of Venus.

from common languages are translated into English in order to determine, inter alia, their confusing similarity to English word marks. **In re Ithaca Industries, Inc.**, 230 USPQ 702 (TTAB 1986).

It does not require any authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States. Id. Although non-Italian speakers, or those having only a rudimentary knowledge of the language, may not know the word "Rinascimento," the word is not so obscure that Italian speakers in the United States would not be familiar with it. Therefore, applicant's arguments to the contrary, we find that the doctrine of foreign equivalents applies, and that, although applicant's mark differs from the cited mark in appearance and pronunciation due to the fact that applicant's mark is in Italian and the cited mark is in English, they must be considered to be identical in connotation.

When the marks are considered in connection with applicant's goods in Class 25, we find that this single similarity in connotation is sufficient to support a finding of likelihood of confusion. Applicant's Class 25 goods are legally identical in part to the women's sweaters identified in the cited registration, and closely related

in part. Specifically, the "pullovers" identified in the application must be deemed to be encompassed within the registrant's identified women's sweaters, while items such as skirts, trousers and shirts are complementary, because they can be bought with a sweater as part of an outfit. It is well-established that when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In view thereof, the fact that the marks have the same connotation is sufficient for us to conclude that confusion is likely, despite the differences in their appearance and pronunciation. **In re American Safety Razor Co.**, 2 USPQ2d 1459 (TTAB 1987).

A different result obtains when we consider the issue of likelihood of confusion with respect to the goods in Class 18. The Examining Attorney has submitted no evidence whatsoever to show that women's sweaters are related to any of applicant's Class 18 goods. Although in her brief the Examining Attorney states that all of applicant's identified goods are "highly related to registrant's 'women's sweaters'" and that "the applicant has not argued otherwise," brief, p. 5, in fact applicant specifically

stated, at p. 3 of its brief, that "at a minimum, applicant's application should be allowed with respect to the Class 18 goods, since there is no overlap with registrant's Class 25 goods."⁶

It is certainly common knowledge that items such as handbags and purses are fashion accessories, and are frequently chosen to complement an outfit. However, we are not aware of a fashion practice of matching handbags and sweaters. Thus, we cannot say, on this record, that handbags, purses, or any of applicant's other goods in Class 18, and women's sweaters, are complementary items. Nor is there any evidence, such as third-party registrations, that would indicate that women's sweaters and handbags and the like are sold by the same entity under a single mark. We recognize that designers may use their names/trademarks for a wide variety of fashion items, but

⁶ The dissent points out that this statement is the sum total of applicant's argument as to why there is no likelihood of confusion between its mark for its identified Class 18 goods, and the cited registration. Whether or not the dissent is implying that applicant has done a less than stellar job in defending its position, the fact remains that the burden of proving likelihood of confusion is on the U.S. Patent and Trademark Office, and as has been noted, the Examining Attorney has failed to submit any evidence whatsoever as to the relatedness of applicant's Class 18 goods and the registrant's identified goods, but has only made the unsupported statement that the goods are "highly related." Otherwise, she, too, has made no argument other than what has been quoted above in support of her position that the goods are related.

in this case RENAISSANCE is not the name of a designer. As a result, the most we can say, on this record, is that applicant's handbags and purses are only tangentially related to the registrant's women's sweaters, in that they are all fashion items. In these circumstances, therefore, we find that the differences in the appearance and the pronunciation of the marks outweigh the fact that they are identical in connotation. See **In re L'Oreal S.A.**, 222 USPQ 925 (TTAB 1984), in which the Board found HAUTE MODE for hair coloring cream shampoo not likely to cause confusion with HI-FASHION SAMPLER for finger nail enamel, despite the fact that "haute mode" means "high fashion." Accordingly we find that the Office has not shown that applicant's mark, if used on its enumerated Class 18 goods, is likely to cause confusion with the cited mark.

Decision: The refusal of registration on the ground of likelihood of confusion is affirmed with respect to the application in Class 25, and reversed with respect to the application in Class 18. The requirement for an acceptable translation is affirmed as to both classes. In view thereof, the application may not go forward to publication in either class. Applicant is advised that, if it wishes to submit the required translation, it must petition the

Director to reopen the application. See Trademark Rules 2.142(g) and 2.146(a)(2).

Simms, Administrative Trademark Judge, dissenting:

While I agree with the majority that there will be likelihood of confusion when applicant's mark RINASCIMENTO and design is used for various items of clothing with registrant's mark RENAISSANCE for women's sweaters, I disagree with the majority's conclusion that there will be no likelihood of confusion with respect to applicant's mark for its Class 18 goods (bags, handbags, purses, wallets, suitcases, beauty cases sold empty, document cases, umbrellas, handsacks, namely clutch bags, and luggage) and registrant's mark.

First, on page 7 of its opinion, the majority has correctly quoted the total of all of applicant's argument in this entire case with respect to the differences of the goods of applicant and registrant. That is to say, in all of the papers applicant has filed in this case, applicant has presented only one sentence of argument about the goods. See applicant's brief, 3 ("at a minimum, applicant's application should be allowed with respect to

the Class 18 goods, since there is no overlap with registrant's Class 25 goods").

Of course, when comparing the goods of an applicant with those of a registrant, it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source, or that there is an association or connection between the sources of the respective goods. See, for example, **In re Martin's Famous Pastry Shoppe, Inc.**, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); **In re Opus One Inc.**, 60 USPQ2d 1812, 1814-15 (TTAB 2001); **In re Melville Corp.**, 18 USPQ2d 1386 (TTAB 1991); and **McDonald's Corp. v. McKinley**, 13 USPQ2d 1895, 1898 (TTAB 1989).

For example, as the Court of Appeals for the Federal Circuit stated in **Recot, Inc. v. M.C. Becton**, 214 F.3d 1332, 54 USPQ2d 1895, 1898 (Fed. Cir. 2000):

[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods

can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.

See also, **Bose Corporation v. QSC Audio Products, Inc.**, 293 F.3d 1367, 63 USPQ2d 1303, 1309-1310 (Fed. Cir.

2002)("Hence the products as described in the pertinent registrations are not the same. But they are related as required by DuPont."); and **Hewlett-Packard Company v. Packard Press, Inc.**, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services").

Moreover, in order to affirm a refusal, it is only necessary that we find likelihood of confusion with respect to at least one item in the Class 18 identification of goods. See **Tuxedo Monopoly, Inc. v. General Mills Fun Group**, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)("[L]ikelihood of confusion must be found if the public, being familiar with [opposer's] use of MONOPOLY for board games and seeing the mark on any item that comes within the description of goods set forth by appellant in its application..." Emphasis in original). Accordingly, for the likelihood-of-confusion analysis, one may consider

only such Class 18 goods as handbags, clutch bags, purses, wallets and umbrellas.

While the majority has stated that there is no evidence that a purchaser may try to match a sweater with various fashion accessories such as handbags and purses, this is only one factor which may contribute to the likelihood of confusion. Indeed, the majority has acknowledged that designers may use their names or marks for a variety of fashion items. To the extent that purchasers are aware of the use of fashion designers' names and marks used in connection with both clothing and accessories, purchasers may be conditioned to expect that clothing and accessories such as handbags and purses bearing the same mark may come from the same source.

In this regard, I agree with the Examining Attorney that women's sweaters and such goods as handbags, purses and wallets are closely related. These goods would be sold in some of the same channels of trade--clothing stores, department stores, boutique stores, mass merchandisers, etc.--to the general public. Also, women's sweaters and handbags and purses may be found at relatively inexpensive prices.

I also note that there is no evidence in the file of any "weakness" of registrant's mark RENAISSANCE. For

example, there are no copies of any third-party registrations of similar marks for related goods.

With respect to the word RINASCIMENTO, applicant has argued, reply brief, 2, that this is "an unusual and obscure word." I cannot agree with this statement. Moreover, as the Examining Attorney contends, RENAISSANCE is the direct English translation and exact synonym of applicant's mark RINASCIMENTO. This is not a case, therefore, where the word which comprises a mark has a number of different meanings. See, for example, **In re Sarkli Ltd.**, 721 F.2d 353,220 USPQ 111 (Fed. Cir. 1983); see also **In re Perez**, 21 USPQ2d 1075 (TTAB 1991) and **In re Buckner Enterprises Corporation**, 6 USPQ2d 1316 (TTAB 1987). Of course, one of the reasons behind the doctrine of foreign equivalents is that the owner of a mark should be able to use and protect a translation of its mark that it may use or might want to use abroad or even in certain markets in this country.

In brief, a purchaser aware of registrant's RENAISSANCE women's sweaters who then encounters the exact foreign equivalent mark RINASCIMENTO (and design) used on related fashion accessories such as handbags, purses and wallets is likely to believe that all of these goods come

from the same source, or are produced under sponsorship or license of the same trademark owner.

Finally, if there were any doubt about likelihood of confusion in this case, we should, in accordance with precedent, resolve such doubt in favor of the registrant and against applicant. **In re Shell Oil Co.**, 992 F.2d 1204, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993); **In re Hyper Shoppes (Ohio) Inc.**, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and **In re Martin's Famous Pastry Shoppe, Inc.**, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

I would affirm the refusal under Section 2(d) as to both classes of the application.